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REMARKS

Claims 1-12 and 14-24 are presently at issue in this application.

REJECTION UNDER 35 USC §112, ¶2

The examiner rejects claims 22 and 23 as indefinite under 35 USC §112, ¶2, claim 22 being characterized as an improper 'use' claim providing insufficient antecedent basis for the referent limitation in claim 23. This rejection is respectfully traversed.

Claim 22 as previously amended is drawn to a composition made up of a compound of formula I as claimed in claim 14, or an acceptable salt thereof, and conventional auxiliaries. This claim is not in an improper 'use' format. Claim 23 is drawn to a process for preparing a composition as claimed in claim 22, and the composition subject matter of claim 22 provides sufficient antecedent basis therefor. Applicants respectfully request that the rejection of these claims as indefinite be withdrawn.

REJECTION UNDER 35 USC §112, ¶1

The examiner rejects all claims under 35 USC §112, ¶1 for a lack of enabling disclosure in the specification. This rejection is respectfully traversed.

The enablement requirement is that sufficient information must be disclosed in the specification as filed to ensure that one of skill in the art can make or use the

claimed invention without undue experimentation. *Mineral Separation v. Hyde*, 242 U.S. 261 (1916); *In re Wands*, 858 F.2d 731, 8 USPQ2d 1200 (Fed. Cir. 1988). In the present case, the examiner's concerns are needless, as sufficient information *is*, in fact present in the specification as filed and/or was available in the art at the time of filing, to meet the enablement requirement.

The examiner shoulders the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention. *In re Wright*, 999 F.2d 1557, 27 USPQ2d 1510 (Fed. Cir. 1993). In the present office action, the examiner raises several different issues in relation to the processes of making and using the presently claimed compounds. The examiner states that enablement is lacking for compounds in which several substituents (R^5 and R^{7-9}) are themselves substituted with from 2 to 3 electron withdrawing groups, including cyano or nitro groups. This lack of enablement is said to be in terms of "placing all of the alleged products in the possession of the public." Office Action p.3. Applicants interpret this to mean that the examiner doubts the ability of one of skill in the art to *make* the indicated compounds. As the examiner does not articulate the *reasons* behind this implication, applicants are left to assume what they can, namely that producing claimed compounds bearing the indicated substitutions would require undue experimentation.

However, the present specification contains two examples of such compounds produced by processes disclosed therein (examples 2.11 and 2.46). Further, knowledge of such chemical manipulations is evident in the commercial availability of

compounds at issue, and in texts demonstrating particular conditions for their reaction. See attached excerpt from *Methoden der Organischen Chemie*. Accordingly, no undue experimentation would be required for a relevantly skilled artisan to make the compounds indicated.

The examiner next turns to an analysis based on the *Wands* factors, in which she touches briefly on the synthesis of the claimed compounds, and focuses the remainder of her remarks on the application of these compounds. As we have discussed synthesis of the relevant compounds above, we will not do so again here. The examiner states that in terms of breadth, the claims cover a range of compounds more extensive than that tested. The claimed invention is said to relate to herbicidal control of plants. Predictability in the art and the amount of direction are said to be low, both assessments being based on absence of actual data in the specification. Finally, the examiner indicates that the entire breadth of the claimed compounds is not tested. Applicants are not certain whether the *use* portion of this rejection is restricted to the substituted compounds discussed initially, or is extended to all claimed compounds.

As the examiner certainly knows, enablement analysis using the *Wands* factors is ultimately based on the evidence *as a whole*. In reviewing the examiner's statements applying *Wands*, applicants initially reply that the examiner has incorrectly categorized the relevance of reported data by including it in an assessment of predictability in the art. Such data is properly included in an assessment of the amount of direction given in the specification.

Applicants are certain that the examiner is aware that as the level of knowledge publicly held by those of skill in the art increases, the amount of disclosure necessary to meet the enablement requirement decreases. The present specification gives clear directions as to the preparation of herbicidal compounds, including concentration and purity of the active ingredients, forms the preparations may take, and auxiliaries conventionally used. See pp.84-86. Further, the specification discloses eight specific preparative examples, including one using compound 2.46 (example VI). See pp.86-87. In addition to these preparative directions, the specification states that the claimed compounds are to be applied in rates of from 0.001 to 3.0 kg/ha, with a preferred range of 0.01 to 1.0 kg/ha. See pp.88. These application rates are said to depend on the control target, the season, the target plants, and the growth stage, each of which are parameters well within the understanding of the skilled artisan. *Id.*

The specification indicates that the claimed range of compounds is effective in the disclosed preparations and applications. As has been indicated, the specification disclosure is presumptively accurate, and where disclosure corresponds in scope to the claimed subject matter, enablement is also presumed. *In re Marzocchi*, 439 F.2d 220, 169 USPQ 367 (CCPA 1971). The examiner bases the present enablement rejection for the most part on a lack of disclosure of specific data. However, the applicants have qualitatively disclosed such results in the specification, and implied that such results are typical of the claimed range of compounds. As the disclosure, therefore, corresponds to the claimed subject matter, the examiner cannot reject on the basis of enablement

without articulation of *reasons* why one of skill in the art would doubt the objective truth of the statements set forward. To state it differently, the examiner must give adequate reasons why one of skill in the art would not expect that the claimed genus could be used in the manner claimed without undue experimentation.

The examiner states that

undue experimentation would be required to make or use the invention based on the content of the disclosure due to the breadth of the claims, the level of predictability in the art of the invention, and the poor amount of direction provided by the inventor. Taking the above factors into consideration, it is not seen where the instant claim is enabled by the instant application.

Office Action, p.5. The examiner's reasoning does not point out *reasons* why one of skill in the art would doubt the asserted effectivity of the claimed compounds.

Accordingly, the enablement rejection is legally deficient, and should be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, applicants consider that the rejections of record have been obviated and respectfully solicit passage of the application to issue.

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Respectfully submitted,
KEIL & WEINKAUF

A handwritten signature in black ink, appearing to read "David C. Liechty", with a long horizontal line extending to the right.

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